REMARKS

This application has been reviewed in light of the Office Action dated April 18, 2006. Claims 1-5, 7-10, 14-19, 21-24, 28 and 30-37 are presented for examination, of which Claims 1, 8, 15, 22, 30, 31, 36 and 37 are in independent form. Claims 6, 11-13, 20, 25-27 and 29 have been cancelled, without prejudice or disclaimer of subject matter. Claims 1, 4, 5, 8, 15, 18, 19, 22, 30, 31, 36 and 37 have been amended to define still more clearly what Applicants regard as their invention. Favorable reconsideration is requested. The canceled claims will not be further addressed herein.

As discussed in detail below, the specification has been amended to overcome the objection under 35 U.S.C. § 132(a) set forth in the April 18, 2006 Office Action. In addition, the specification has been amended for purposes of clarity. No new matter has been added through these amendments.

The Amendment filed July 15, 2005 was objected to under 35 U.S.C. § 132(a) on the ground that it introduces new matter. In particular, the Office Action states that all of the additions and deletions set forth in Applicants' amendments to the Specification (pages 2-5) filed July 15, 2005 are not supported by the initial disclosure. While Applicants do not agree that this amendment added new matter to the original disclosure, in an effort to advance prosecution, the additions have been removed and the deletions have been reapplied.

Claims 1, 8, 15, 22, 29, 30, 31, 36 and 37 were rejected under 35 U.S.C. § 112, first paragraph, for lack of enabling disclosure and under 35 U.S.C. § 112, second

paragraph, as indefinite. Specifically, the phrase "wherein the changing means changes the size of the output image data before said transmitting means starts to communicate with the receiving apparatus" was objected to as non-enabling, vague and indefinite. While Applicants do not agree that this phrase is non-enabling, nor vague and indefinite, this phrase has been deleted from the rejected claims. It is believed that the rejections under Section 112, first and second paragraphs, have been obviated, and their withdrawal is therefore respectfully requested.

In the first set of rejections, Claims 1-5, 7-10, 14-19, 21-24, 28, 33, 36 and 37 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,659,164 (Schmid); and Claims 34 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmid.

In the second set of rejections, Claims 1-5, 7-10, 14-19, 21-24, 28 and 30-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmid, in view of U.S. Patent No. 5,019,916 (Ogura).

As shown above, Applicants have amended independent Claims 1, 8, 15, 22, 30, 31, 36 and 37 in terms that more clearly define what they regard as their invention.[1/] Applicants submit that these amended independent claims, together with the remaining

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1/In amended Claims 1 and 8, the information processing apparatus corresponds to the item 3000 in Figure 1, and the facsimile apparatus corresponds to item 4000 in Figure 1. The setting means is supported in the original disclosure at least at page 34, lines 7-9, and the elements of the facsimile apparatus are supported in the original disclosure at least at page 37, lines 15-26.

claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

Claim 1 is directed to an information processing system having a facsimile apparatus and an information processing apparatus. The information processing apparatus includes: (1) temporary storing means for temporarily storing, on a storage medium, output image data composed of a plurality of pages, for causing the facsimile apparatus to transmit to a receiving apparatus, as well as output configuring information; (2) acquisition means for acquiring output size of a prescribed page from the output configuring information of the output image data stored temporarily by the temporary storing means; (3) addition means for adding a cover page to the output image data; (4) setting means for setting the size of the cover page added by the addition means to the output size of the prescribed page acquired by the acquisition means, and (5) transferring means for transferring to the facsimile apparatus for causing the facsimile apparatus to transmit the cover page and the output image data to a receiving apparatus, the cover page to which the output size has been set, the output image data temporarily stored by the temporary storing means and address information of the receiving apparatus.

The facsimile apparatus includes: (1) receiving means for receiving the cover page, the output image data and the address information transferred by the transferring means; (2) expansion means for expanding the cover page based on the size of the cover page set by the setting means; and (3) transmitting means for transmitting the

cover page expanded by the expanding means and the output image data to the receiving apparatus in accordance with the address information received by the receiving means.

Schmid relates to automatically creating, identifying, routing and storing digitally scanned documents. In the Schmid system, pages of originals are scanned in, and each page of data is associated with corresponding page-specific data. The originals are preceded by a cover sheet having machine-readable coded information (MRI), indicating parameters, including page size, of the following pages, and routing information. By scanning and analyzing the MRI, the following pages are processed using the parameters derived by analyzing the MRI. However, Applicants have found nothing in Schmid that would teach or suggest "acquisition means for acquiring output size of a prescribed page from the output configuring information of the output image data stored temporarily by said temporary storing means," "setting means for setting the size of the cover page added by said addition means to the output size of the prescribed page acquired by said acquisition means," or "expansion means for expanding the cover page based on the size of the cover page set by said setting means," as recited in Claim 1.

In addition, in Schmid, the MRI on the cover sheet is utilized to determine processing parameters for the following pages and, thus, in contrast to Claim 1, the size of the cover page is irrelevant. Further, Applicants have found nothing that would teach or suggest "transferring means for transferring to said facsimile apparatus for causing said facsimile apparatus to transmit the cover page and the output image data to a receiving apparatus, the cover page to which the output size has been set, the output image data

temporarily stored by said temporary storing means and address information of the receiving apparatus," as recited in Claim 1. Indeed, nothing in Schmid teaches or suggests that the information processing apparatus and facsimile apparatus are even connected.

Accordingly, Applicants submit that Claim 1 is allowable over Schmid.

A review of the other art of record has failed to reveal anything which, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as references against Claim 1.

In particular, Ogura, which is cited as a secondary reference in the second set of rejections, does not remedy the deficiencies of Schmid. Ogura relates to a digital copier having a facsimile function, where the transmitting side changes the size of a document to be transmitted according to the paper size available at the receiving side, and based on size information transmitted by the receiving side. When an operator selects the transmission mode, a facsimile control transfers the receiving facsimile device's telephone number to a network control, which calls the receiving facsimile device. As the line is established, the facsimile control executes a transmission control procedure to identify the receiving facsimile device's receiving functions, including available paper size. If the size of the document to be transmitted is different from the size available at the receiving facsimile device, the document is transmitted after being changed in size.

However, nothing has been found in Ogura that would teach or suggest any of the above mentioned features of Claim 1.

Accordingly, even under the second set of rejections, Applicants submit that Claim 1 is patentable over Schmid and Ogura, whether considered separately or in any permissible combination (if any).

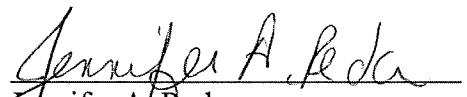
Independent Claims 8, 15, 22, 29, 30, 31, 36 and 37 recite features similar to those discussed above with respect to Claim 1 and, therefore, are also believed to be patentable over the cited prior art for the reasons discussed above.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, early and favorable continued examination of the present application is respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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